



09-06-05

~~AFW~~ IFW

Application No. : 10/707,437  
Applicant : David Liang Mabbutt  
Filed : 14 December 2003  
Title of Invention : IMPROVED MOUSE PAD  
Examiner : Gwendolyn Baxter  
Docket No. : DMABB05F  
Customer No. : 33310

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

A. REAL PARTY IN INTEREST

David Liang Mabbutt, sole inventor and sole applicant, represented by Edwin A. Skoch,  
registered patent attorney.

B. RELATED APPEALS AND INTERFERENCES

None.

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### C. STATUS OF CLAIMS

Claims 1 through 14 were twice rejected by Examiner Gwendolyn Baxter, first by Office Action dated September 23, 2004, and second by Office Action, dated March 9, 2005.

### D. STATUS OF AMENDMENTS

Applicant offered clarifying amendments --which were provided to the Examiner via email and which are included in the Appendix--during a telephonic conference after Final Rejection, but the Examiner would not allow any amendments.

### E. SUMMARY OF CLAIMED SUBJECT MATTER

A mouse pad with one or more perpendicular elements anchored into it, said elements providing a barrier or bumper function to discourage the mouse from traveling off the mouse pad while the mouse is in use. The perpendicular elements and mouse pad can take the appearance of sports themes. The mouse pad can be marked for promotion purposes.

### F. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1.) Claim #1 was rejected as anticipated by Gillespie (# 6,125,032) and also anticipated by a picture found on the world wide web, of a product for sale called the "Information Fairway Mouse Pad." The dependent claims 2 through 9 and 13 were consequently rejected.

Gillespie is a three-dimensional, themed diorama meant to make a computer more visually appealing, with attachments to the computer screen, mouse pad, and wrist pad. The mouse pad attachment is in the form of a “mouse house” into which the mouse can be inserted and stored.

2.) Claims 10, 11, and 14 were rejected as anticipated Gillespie (# 6,125,032). The rejection of Claim 11 is not on appeal.

3.) Claim 12 was rejected as anticipated by Gillespie (# 6,125,032). The rejection of Claim 12 is not on appeal.

4.) Claims 1, 2, 4, 8, 10, 11, and 14 were rejected as being obvious, in light of Gillespie (# 6,125,032).

5.) Claims 3, 5, and 9 were rejected as being obvious in light of Gillespie (# 6,125,032), in view of Depiero (# 5,952,070).

Depiero discloses a mouse pad that is a thin, transparent sheet of plastic which can be stuck to a surface using an adhesive.

6.) Claim 13 was rejected as being obvious in light of Gillespie (# 6,125,032), in view of Murphy (# 5,876,010).

Murphy is a mouse pad formed by a pad of paper with multiple sheets that can be written on and sheets torn off.

## G. ARGUMENT

1.) Claims #1 and dependent claims 2 through 9 and 13 were not anticipated by Gillespie (# 6,125,032) because Gillespie does not teach several limitations in the present disclosure.

The §102 anticipation standard requires that a single reference teach each and every element of the application, expressly or inherently, to one of ordinary skill in the art.

a.) “Anchored in” limitation is not present in Gillespie:

Regarding the mounting of the perpendicular elements to the mouse pad, Gillespie does not teach an essential limitation in the present disclosure: i.e., anchoring the member into the mouse pad.

The Examiner admitted as such: Gillespie “fails to teach the member or members being anchored in the mouse pad.” (See page 3, last line, of Office Action dated March 9, 2005).

Contrast this with the present disclosure, paragraphs 61 (“anchored in the flexible material”), 19 (“inserted into”), and 48, and claims 1-9, and 13 of the present disclosure.

For this reason, the anticipation rejection using Gillespie cannot stand, and must be withdrawn, as it is an improper §102 rejection.

b.) Use of the mouse limitation is not present in Gillespie:

Gillespie teaches that the mouse pad have “an enclosure that is used for the storage of a mouse” (see # 6,125,032, column 3, line 21). Even more specifically, Gillespie says that the “enclosure” or “mouse house” (column 3, line 20) must have “an opening” for “inserting and removing” the mouse (column 3, lines 23-24, and claims 1 through 13).

The language of Gillespie makes it plain that the mouse is not to be used as a pointing device while it is in the enclosure. It is to be “stored” inside and cannot be used while in its “mouse house.”

The present disclosure forecloses the possibility of having an “enclosure” or “mouse house.” An “enclosure” is antithetical to the idea embodied in the present disclosure. Put another way, a bumper or barrier for a mouse being used as a pointing device is not useful if one is storing a mouse in an enclosure. Logically, then, the lack of an “enclosure” is a limitation taught in the present disclosure. For this reason, Gillespie does not anticipate an essential element of the present disclosure: the lack of an enclosure, or the use of the mouse as a pointing device.

c.) the “bumper” or “barrier” limitation is not present in Gillespie:

Since Gillespie teaches an enclosure, Gillespie’s “mouse house” does not have the essential limitation of providing a bumper or “barrier to discourage mouse movement.” (see claim 1 and paragraph 47).

The present disclosure has a limitation of “providing a barrier to discourage mouse movement off” the edge of the mouse pad (see claim 1), “while [the mouse pad is] in use” (see paragraph 16). The current disclosure makes clear that the perpendicular element is meant to be a bumper or barrier to the mouse traveling off the mouse pad while it is in use (see, e.g., claim 1, paragraph 46, and paragraph 19). The mouse does not go into anything, but, rather, bumps off of the perpendicular element “while attempting to scroll the cursor around the screen with the mouse.” (paragraph 6).

First, in Gillespie, while the mouse is certainly stopped or motionless while in the “mouse house,” this is because it is inserted in the “enclosure” for “storage,” and not by any properties of the “mouse house” itself. Equating the “mouse house” with a “barrier to discourage movement” is like equating an auto bridge guardrail with a car garage: parking a motionless car in a garage essentially keeps it from going off the road, just as does a guardrail, but certainly not in the same logical sense.

Further, Gillespie’s “mouse house” is not anchored to the pad by any means that its outside shell would provide a barrier to the mouse. Anything not anchored in the pad will not serve as a barrier. Gillespie specifically teaches only that the “mouse house” is secured “to the surface” (see claim 3, column 6, line 32) and that the mounting is done “either frictionally or through the use of an adhesive tape or other securing method such as an adhesive glue.” (column 3, lines 31-33).

In order to provide a barrier, the element must prevent mouse movement. Anchoring provides an improvement over surface attachment. In other words, the bumper/barrier limitation necessitates stronger attachment, such as anchoring, to overcome the problems with surface mounting.

Without “anchoring” the perpendicular members into the mouse pad, the members would peel or tear off when bumped by the mouse.

2.) Claims #1 and dependent claims 6, and 7 were not anticipated by the pictured “Information Fairway Mouse Pad” because it does not teach several limitations in the present disclosure.

a.) “Anchored in” limitation is not present in the picture:

There is no indication from the “Information Fairway Mouse Pad” picture that the flagpole is “anchored” into the mouse pad. The manner of flagpole mounting cannot be discerned from the reference.

As noted in the preceding sections (particularly Section G.1.a. above), without this limitation, the reference does not teach a limitation present in this disclosure.

b.) The “hole” limitation of claims #6 and 7 is not present in the “Information Fairway Mouse Pad” reference:

Claim 6 has the stated limitation that the upright member has a “golf hole.” Dependent claim 7 likewise retains this limitation.

There is no indication in the picture that the reference has a “golf hole.” On the contrary, it appears in the picture that there is no facsimile of a hole at the base of the flagpole. For this reason, the “Information Fairway Mouse Pad” reference does not contain a limitation of the present disclosure.

c.) the “bumper” or “barrier” limitation is not present in the “Information Fairway Mouse Pad”:

As noted in the preceding sections (particularly above section G.1.c.), there is no indication from the reference that the flagpole could be used as a bumper or barrier to prevent the mouse from traveling off the pad while the mouse is in use. As noted above, secure attachment of a flagpole would be necessary in order to serve this purpose. There is no indication from the reference as to the means of attachment of the flagpole in the “Information Fairway Mouse Pad.”

For this reason, the “Information Fairway Mouse Pad” reference does not contain a limitation of the present disclosure.

3.) Claims 1, 2, 4, 8, 10, and 14 are not obvious in light of Gillespie (# 6,125,032) because Gillespie teaches away from elements and limitations in the present disclosure.

The §103 obviousness standard requires that an examiner point out references, which were available to the inventor, which teach a suggestion to modify or combine the references in a way that the combination would have made the invention obvious to one of ordinary skill in the art.

“[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual



to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988). The requirement that a showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998).

a.) Gillespie teaches away from secured mounting of the element onto the mouse pad.

Gillespie specifically teaches only that the “mouse house” is “secured to the working surface” (see claim 3; column 6, line 32) and that the mounting is done “either frictionally or through the use of an adhesive tape or other securing method such as an adhesive glue.” (column 3, lines 31-33). This is antithetical to the “anchoring” limitation in the present disclosure. No other mounting, other than light, superficial mounting, is contemplated by Gillespie.

There is no suggestion or teaching anywhere in Gillespie that a “mouse house” should be “anchored” to the mouse pad, such as by passing a peg through the pad material.

On the contrary, the pegs in Gillespie serve a completely different function. The reason for the use of “pegs” in Gillespie is to allow for interchangeable “mouse houses,” and not to securely fasten the “mouse house” to the mouse pad. (see column 3, lines 46-48). This is evidenced in the fact that the pegs themselves are surface mounted.

Since Gillespie is essentially a non-functional diorama, Gillespie's mounting allows for a quick change of the diorama to quickly change the appearance of its "decorative array." Constructing the decorative array in such a manner as to achieve a quick change of the mouse house would allow the mouse house to become quickly dislodged if struck by a mouse. Easily interchanged mouse houses means they cannot be anchored. Not anchored means it would not provide a barrier or bumper function to mouse movement.

b.) Gillespie teaches away from the use of the mouse with respect to the element on the mouse pad.

Gillespie specifically teaches a mouse pad with "an enclosure that is used for the storage of a mouse" (see # 6,125,032, column 3, line 21). It further requires that its "enclosure" or "mouse house" (column 3, line 20) must have "an opening" for "inserting and removing" the mouse (column 3, lines 23-24, and claims 1 through 13). Having a "mouse house" that is used for mouse "storage" is antithetical to the idea of a mouse being used continually, as in the present disclosure.

As noted in the previous sections, there is no suggestion anywhere in Gillespie that the mouse could continue to be used while in the "mouse house." The only reasons for the existence of Gillespie's "mouse house" are decoration and storage.

c.) Gillespie teaches away from the "bumper" or "barrier" function present in the instant disclosure.

The reasons for the existence of the Gillespie “mouse house” are noted above. There is no suggestion that the “mouse house” exists for any reasons other than “storage” and decoration.

The entire concept of the present enclosure is a bumper or barrier to prevent a mouse from moving off the mouse pad while the mouse is in use. This utility is other than merely decorative, unlike Gillespie’s “decorative array.”

First, it is illogical to say that storing a mouse inside an enclosure is equivalent to preventing it from moving off the mouse pad, as noted above.

Further, the Examiner is missing the point of the present disclosure, and Gillespie’s patent, with the assertion that it would have been obvious “to have provided the peg on the bottom of the member or member [sic] while the mouse pad provided with [sic] the openings for receiving the pegs therein.” (page 4, Office Action of March 9, 2005). The reason for the use of “pegs” in Gillespie is to allow for interchangeable “mouse houses,” and not to securely fasten the “mouse house” to the mouse pad. (see column 3, lines 46-48). If, as the Examiner argues, pegs could have been put on the bottom of the “mouse house,” an essential feature of Gillespie’s “mouse house” and its pegs would then be missing: the decorative “mouse house” would not have been capable of “exchanging [the] mouse house with other mouse houses with different themes....” (see column 3, lines 46-47). The Examiner has, in hindsight, added a new feature to Gillespie which was not present: holes in the mouse pad.

As noted above, 'interchangeable' or "exchangeable" means that the mouse house would not be a barrier because it can become easily dislodged.

4.) Claims 1, 2, 4, 8, 10, and 14 are not obvious in light of Gillespie (# 6,125,032) because Gillespie is non-analogous art.

According to the federal courts, "[t]wo criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved . . . . A reference is reasonably pertinent if . . . it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem . . . . If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, . . . [i]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it." *In re Clay*, 23 USPQ 2d 1058, 1060–61 (Fed. Cir. 1992). Further, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780, 1783–84 (Fed. Cir. 1992).

Gillespie is primarily classified under class 361/683, which is for ELECTRICITY:  
ELECTRICAL SYSTEMS AND DEVICES/ HOUSING OR MOUNTING ASSEMBLIES  
WITH DIVERSE ELECTRICAL COMPONENTS/ For electronic systems and devices /

Computer related support. This means that the USPTO considered Gillespie to have an electrical appliance housing application. That is, the Office felt that it was primarily a storage unit for a mouse, a field of endeavor entirely distinct from the present disclosure. It deals with a problem entirely distinct from the present disclosure.

Gillespie himself believed his invention to be a “decorative array” that was meant to make “a computer more enjoyable and fun” and to “stimulate [] interest in computing.” (see column 1, lines 16-22). Gillespie’s stated problem to be solved is how to “personalize” a computer since there were “deficiencies in computer system appearance.” (see column 1, lines 38-43). The “decorative array” description occurs in Gillespie’s every claim, making Gillespie somewhat more of a design patent than a utility patent, perhaps. The entire focus of Gillespie is on appearance. This focus on appearance makes Gillespie non-analogous to the present disclosure, which focuses on assisting the user in the usage of a mouse as a pointing device. Once again, a field of endeavor and problem solution entirely distinct from the present disclosure.

As such, there is no suggestion in Gillespie to modify the “mouse house” or its mounting to achieve the problems solved in the present disclosure. Gillespie used surface-mounted pegs on his mouse house so his decorative array could be quickly changed.

5.) Claims 3, 5, and 9 are not obvious over Gillespie (# 6,125,032) in light of Depiero (# 5,952,070) because the thinness of Depiero’s sheet of Lexan would prevent anchoring of the element into the thin sheet.

Depiero teaches using a thin sheet of Lexan (.005 inches: see column 2, lines 55-57) glued to a desk surface as a surface upon which to use a mouse. While Gillespie's mouse house might be glued to the top of a Lexan sheet, and serve the decorative purposes that is Gillespie's disclosure, one could not anchor an element into a thin Lexan sheet. It is further not obvious that one could anchor Gillespie's mouse house into Depiero's .005-inch plastic sheet. It appears that Depiero might provide the basis for a Gillespie mouse house, but irrespective of this, it does not follow that this combination could teach the anchoring of an element into the plastic sheet.

6.) Claim 13 is not obvious over Gillespie (# 6,125,032) in light of Murphy (# 5,876,010) because the combination of Gillespie's attachment to Murphy would prevent the use of Murphy's pad of paper.

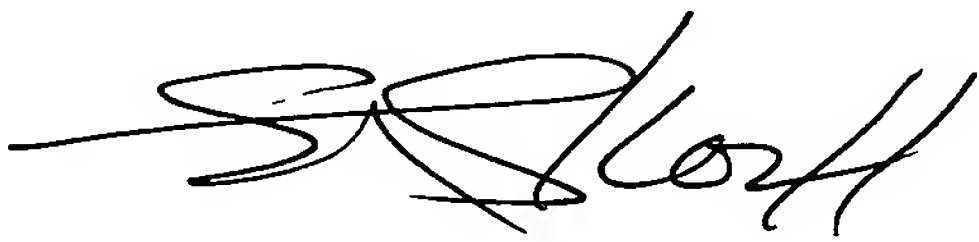
As noted above, Murphy disclosed a mouse pad consisting of a pad of paper "with a plurality of sheets of paper." (see Murphy, all claims.) These sheets are secured along the edges, and can be torn off to offer a new writing surface. (see Murphy, column 1, lines 53-56).

The combination of Murphy with a connected structural element on top of Murphy's pad of paper would prevent an essential function of Murphy: an element would prevent a user from tearing off sheets of paper. Further, were one to anchor an element into Murphy's pad of paper, the result would be even worse: Murphy's functionality would be prevented and his invention would be useless. As such, the combination would not be performed by any one and the references teach away from a combination.

Appl. No. 10/707,437  
Inventor: Mabbutt, David L.  
Improved Mouse Pad

For the above reasons, the Applicant asks that the Board reverse the rejections made by the Examiner and allow the claims in the present disclosure.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Edwin A. Skoch". The signature is stylized with a large, sweeping "E" and "S".

Edwin A. Skoch

Attorney, Reg. No. 50,483, Representing David Mabbutt

## H. APPENDIX

### 1.) Current Listing of Claims

CLAIM 1. A mouse pad, comprising a mouse pad with one or more connectedly attached members at or near the edge of said mouse pad, said member or members anchored in and protruding above the surface of said mouse pad in a roughly perpendicular fashion and providing a barrier to discourage mouse movement off that edge of said mouse pad where said member or members is located.

CLAIM 2. A mouse pad, as in claim 1, wherein said member or members is in the shape of a hockey goal and said mouse pad has the appearance of a full or partial hockey rink.

CLAIM 3. A mouse pad, as in claim 2, further comprising graphics or text, used for promotional purposes.

CLAIM 4. A mouse pad, as in claim 1, wherein said member or members is in the shape of a basketball post, backboard, and hoop and said mouse pad has the appearance of a full or partial basketball court.

CLAIM 5. A mouse pad, as in claim 4, further comprising graphics or text used for promotional purposes.

CLAIM 6. A mouse pad, as in claim 1, wherein said member or members is in the shape of a



golf hole, post, and flag and said mouse pad has the appearance of a full or partial golf green.

CLAIM 7. A mouse pad, as in claim 6, further comprising graphics or text, used for promotional purposes.

CLAIM 8. A mouse pad, as in claim 1, wherein said member is in the shape of a football goalpost and said mouse pad has the appearance of a full or partial football field.

CLAIM 9. A mouse pad, as in claim 8, further comprising graphics or text, used for promotional purposes.

CLAIM 10. A mouse pad, comprising a mouse pad with one or more connectedly attached and raised members near the periphery of said mouse pad, said member or members anchored into said mouse pad and providing a barrier to mouse movement off that mouse pad edge where said member or members are anchored.

CLAIM 11. A mouse pad that can be used as an entertainment device, comprising: a mouse pad resembling the playing surface of a sport in miniature and one or more miniature accessories used in said sport, used to play a facsimile of said sport.

CLAIM 12. A mouse pad that can be used as a promotional device, comprising a mouse pad

with one or more connectedly attached protruding members, whose shape, markings, and protruding member or members resemble the playing area of a sport in miniature.

CLAIM 13. A mouse pad, as in claim 1, wherein said mouse pad further comprises a porous surface that can be written on.

CLAIM 14. A mouse pad that can be used with an optical mouse, comprising a mouse pad with one or more connectedly attached members at or near the edge of said mouse pad, said member or members anchored in and protruding above the surface of said mouse pad in a roughly perpendicular fashion and providing a barrier to discourage the user from placing items on or over said mouse pad.

2.) Proposed Amendment to Claims Provided to Examiner Via Email on June 21, 2005, Before  
Telephonic Conference:

CLAIM 1. (CURRENTLY AMENDED) A mouse pad, comprising a mouse pad with one or more connectedly attached members at or near the edge of said mouse pad, said member or members anchored in and protruding above the surface of said mouse pad in a roughly perpendicular fashion and ~~providing a barrier~~ making a bumper to discourage mouse movement off that edge of said mouse pad where said member or members is located while said mouse is in use.

CLAIM 2. (CURRENTLY AMENDED) A-mouse pad, as in claim 1, wherein said member or members is in the shape of a hockey goal and said mouse pad has the appearance of a full or partial hockey rink.

CLAIM 3. (CURRENTLY AMENDED) A mouse pad, as in claim 2, further comprising graphics or text, used for promotional purposes.

CLAIM 4. (CURRENTLY AMENDED) A mouse pad, as in claim 1, wherein said member or members is in the shape of a basketball post, backboard, and hoop and said mouse pad has the appearance of a full or partial basketball court.

CLAIM 5. (CURRENTLY AMENDED) A mouse pad, as in claim 4, further comprising graphics or text used for promotional purposes.

CLAIM 6. (CURRENTLY AMENDED) A mouse pad, as in claim 1, wherein said member or members is in the shape of a golf hole, post, and flag and said mouse pad has the appearance of a full or partial golf green.

CLAIM 7. (CURRENTLY AMENDED) A mouse pad, as in claim 6, further comprising graphics or text, used for promotional purposes.

CLAIM 8. (CURRENTLY AMENDED) A mouse pad, as in claim 1, wherein said member is in the shape of a football goalpost and said mouse pad has the appearance of a full or partial football field.

CLAIM 9. (CURRENTLY AMENDED) A mouse pad, as in claim 8, further comprising graphics or text, used for promotional purposes.

CLAIM 10. (CURRENTLY AMENDED) A mouse pad, comprising a mouse pad with one or more connectedly attached and raised members near the periphery of said mouse pad, said member or members anchored into said mouse pad and ~~providing a barrier to~~ making a bumper to discourage mouse movement off that mouse pad edge where said member or members are anchored while said mouse is in use.

CLAIM 11. (CURRENTLY AMENDED) A mouse pad that can be used as an entertainment device, comprising: a mouse pad resembling the playing surface of a sport in miniature and one or more miniature accessories used in said sport, used to play a facsimile of said sport.

CLAIM 12. (CURRENTLY AMENDED) A mouse pad that can be used as a promotional device, comprising a mouse pad with one or more connectedly attached protruding members, whose shape, markings, and protruding member or members resemble the playing area of a sport in miniature.

CLAIM 13. (CURRENTLY AMENDED) A mouse pad, as in claim 1, wherein said mouse pad further comprises a porous, permanent, non-paper surface that can be written on.

CLAIM 14. (CURRENTLY AMENDED) A mouse pad that can be used with an optical mouse, comprising a mouse pad with one or more connectedly attached members at or near the edge of said mouse pad, said member or members anchored in and protruding above the surface of said mouse pad in a roughly perpendicular fashion and providing a barrier to discourage the user from placing items on or over said mouse pad.

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Improved Mouse Pad

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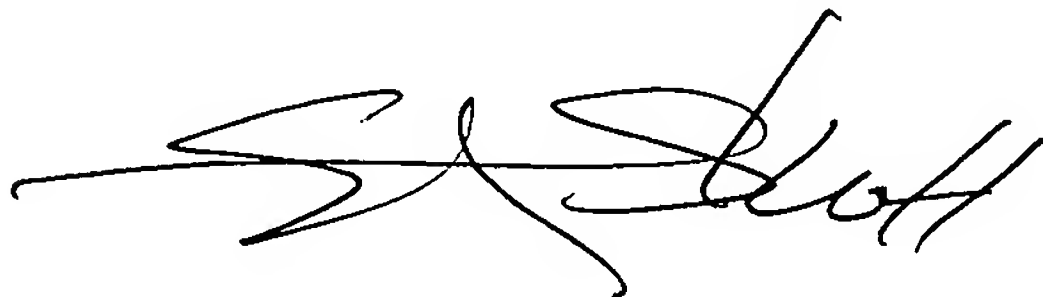
APPEALS BRIEF with Appendix of Claims (21 pages)

for Application 10/707,437 filed 14.12.03, Inventor: David L. Mabbutt

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on September 2, 2005.



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(Signed)

Edwin A. Skoch, Reg. No. 50,483, Cust. No. 33310